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The opinion in support of the decision being entered today is not
binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

JUN 25 2002

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

CHRISTOPHER J. STEVENS,

Junior Party,
(P.N. 5,393,368)

v.

SHIGERU TAMAI,

Senior Party.
(S.N. 08/196,839)

Patent Interference No. 103,662

Before: CRAWFORD, GARDNER-LANE, and MEDLEY, Administrative Patent
Judges.

CRAWFORD, Administrative Patent Judge.

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FINAL DECISION

This interference was declared on May 9, 1997. Tamai's involved application Serial No. 08/196,839 was filed on February 15, 1994. Stevens' involved U.S. Patent No. 5,393,368 was filed on February 7, 1994 and issued on February 28, 1995. At the time this interference was declared, Tamai was accorded the benefit of U.S. Serial No. 08/030,183 (" '183 application") which was filed March 29, 1993 and was accorded senior party status on that basis. Stevens filed a reissue application Serial No. 08/940,815 on September 30, 1997. Stevens' reissue application was added to this interference on September 28, 2000.

The invention at issue in this interference relates to a correction tape dispenser. The particular subject matter in issue is illustrated by count 1, the sole count, as follows:

A correction tape dispenser comprising:

 a tape comprising a carrier ribbon with correction composition thereon,

 supply and take-up spools for the tape,

 a tip having an edge for pressing the tape against a surface

 a portion of the tape between the supply and take-up spools being guided to extend around said edge

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wherein the edge is inclined to a feed direction which is the direction of travel of the tape leaving the supply spool, and

the tip includes guide means on either side of the edge which operate in conjunction with the shape of the tip for twisting the tape so that the path of the tape around the edge between the guide means is in a plane substantially perpendicular to said edge and inclined to the feed direction.

The claims of the parties which correspond to this count are:

Stevens' patent: Claims 1 through 5, 7 through 16 and 18 through 21.

Stevens' reissue application: Claims 1 through 5, 7 through 16 and 18 through 21.

Tamai's application: Claims 1 through 21.

The following matters are before us for review:

- (a) Stevens' motion under 37 CFR § 1.633(a) for judgment.
- (b) Stevens' motion under 37 CFR § 1.633(f) to be accorded the benefit of earlier filed priority applications.

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- (c) Stevens' motion under 37 CFR § 1.633(g) to deny benefit of earlier filed application to party Tamai accorded in notice of interference.
- (d) Tamai's motion under 37 CFR § 1.633(f) for benefit of earlier filed foreign priority applications.
- (e) Stevens' motion under 37 CFR § 1.633(c) to redefine interference subject matter by designating claims of Stevens' U.S. Patent 5,393,368 as not corresponding to the count.
- (f) Stevens' motion to suppress evidence pursuant to 37 CFR § 1.656(h).
- (g) Stevens' objections to evidence of Senior party Tamai.

Redeclaration

The count as originally filed is identical to Stevens' claim 1 and Tamai's claim 20. The claims, however, include means plus function language i.e.:

guide means on either side of the edge which operate in conjunction with the shape of the tip for twisting the tape so that the path of the tape around the edge between the guide means is in a plane substantially perpendicular to said edge and inclined to the feed direction.

When an element in the claim is expressed as a means for performing a specified function, the claim shall be construed to cover the corresponding structure described in the specification

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and equivalents thereof. 35 U.S.C. § 112, paragraph six. Thus, it is possible to have two identical claims with slightly different meanings.

This interference is hereby redeclared, so that the count is the disjunctive alternative union of Stevens' claim 1 and Tamai's claim 20.

The claims of the parties that correspond to the count remain the same.

Thus, for purposes of the priority, a party may demonstrate priority with respect to Stevens' claim 1, which will be interpreted in view of the Stevens specification, or with respect to Tamai's claim 20, which will be interpreted in view of the Tamai specification.

Stevens' Motion under § 1.633(a)

Stevens seeks to have the interlocutory order denying its motion under CFR § 1.633(a) modified. Stevens argues in this motion that claim 20 of Tamai's involved application is unpatentable under 35 U.S.C. § 112, first paragraph, because, in Stevens' view, the Tamai application does not contain a written description of the subject matter of claim 20. Stevens also argues that the disclosure of the Tamai application does not

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enable a person of ordinary skill in the art to make and use the invention.

As this is a substantive issue, we review this interlocutory order de novo.

Written Description

In regard to the written description requirement, Stevens argues that the Tamai description does not disclose:

the tip includes guide means on either side of the edge which operate in conjunction with the shape of the tip for twisting the tape so that the path of the tape around the edge between the guide means is in a plane substantially perpendicular to said edge and inclined to the feed direction.

Specifically, Stevens argues that Tamai does not describe a tip which includes a guide means on either side of the edge which operates in conjunction with the shape of the tip for twisting the tape. In Stevens' opinion, the head 18 of the Tamai device is the only portion of the Tamai device that can be called the tip. Stevens argues that head 18 does not have guide means on either side of the edge. In Stevens' opinion, the flanges 33 are the only guide means on the side of head 18 and these flanges 33 do not perform any twisting function.

Central to Stevens' argument is their contention that the tip in Tamai is the head 18.

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We note that in construing claims in an interference for purposes of a motion under 37 CFR § 1.633(a), the claim is construed in light of the specification of the application in which it appears. As such, we will construe the term "tip" in claim 20 of the Tamai application in light of the disclosure of the Tamai application.

The Tamai application does not explicitly describe a tip. However, the test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

The Tamai application describes a correction tape dispenser having supply and take-up spools, 15 and 16 respectively. The tape is fed out of the supply spool 15 guided on its path by pin 21, guide pin 22, a slit 20 and a flange 33 to arrive at head 18. The tape is then guided on its path from the head 18 by the other flange 33, the other slit 20 and the other guide pin 23 to arrive at the take-up spool 16.

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Stevens argues that the term "tip" which is recited in claim 1 of Stevens is the tip 10. Therefore, the tip which is recited in claim 20 of the Tamai application must be the head 18.

We do not agree with Stevens that the tip recited in claim 1 of the Stevens patent is necessarily the tip 10. In our view, the recitation of a "tip" in claim 1 of Stevens is broad enough to refer to the tip member 10. This interpretation is especially compelling to us in view of the recitation in claim 6 of the Stevens patent of a unitary member. However, as we stated above, claim 20 of the Tamai application is construed in light of the Tamai application for the purposes of a § 1.633(a) motion. As the Tamai application does not expressly define a tip, this term is given its customary meaning. We note that the Webster's Third New International Dictionary (G&C Merriam Co., 1981) defines "tip" as "a pointed or rounded extremity of something" and defines an extremity as "an outlying or terminal part, section or point." When claim 20 is given its broadest reasonable interpretation, we find that the term "tip" is broad enough to include the section of the device below the take-up spool 16.

In the Tamai device, the tape is guided on its path below the take-up spool 16 by guide means 22 and 23, slits 20, and flanges 33. As such, these elements together form the guide means recited in claim 20.

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The tape leaving guide pin 21 is guided and twisted by the combination of actions of the guide pins 22, 23, flanges 33 and head 18. Stevens argues that this twisting is done solely by the pins 22, 23. We do not agree because the twisting of the tape could not be accomplished without the anchoring actions of slits 20 and flanges 33. The twisting would also not be achieved without the overall configuration or shape of the tip of the device. In addition, the shape of the head 18, which is a portion of the tip, guides the tape so that it is traveling in a plane substantially parallel to the edge of the device.

In regard to the language that the path of the tape around the edge is inclined to the feed direction, Stevens argues that this feed direction is the direction of the tape as it leaves the guide pin 22 and that because the tape is traveling parallel to the axis of the device as it leaves pin 22 and also traveling to the head 18 in a direction parallel to the axis of the device, the path of the tape is not inclined to the feed direction.

Claim 20 recites that the feed direction is the direction of travel of the tape leaving the supply spool. In the Tamai device, the tape leaves the supply spool 15 at an angle with respect to the axis of the device while the tape travels parallel to the axis of the device as it travels to the head 18. As such,

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the path of the tape is clearly inclined to the feed direction as it travels to the head.

Enablement

In regard to the question of enablement, Stevens argues that there is no guidance in the Tamai disclosure of how to provide guide means in the head 18 which Stevens views as the tip. As we have stated above, the tip language in claim 20 is broad enough to include the portion of the Tamai device which is below the take-up spool 16. As the guide means includes pins 22, 23, slits 20, and flanges 33, the guide means is disposed at least in part on either side of the edge of the device. Accordingly, Tamai does include a description that would enable one of ordinary skill in the art to make or use a guide means on either side of the edge.

Stevens also argues that there is no recognition that the peak portion of the head 18 is inclined relative to the tape feed direction to allow the coating film transfer tool to be angled forwardly and downwardly in a pen like manner in use.

We note initially that claim 20 does not recite that the coating film transfer tool in use is angled forwardly and downwardly in a pen like manner. Therefore, this portion of the argument is not persuasive because it is not commensurate with

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the actual scope of claim 20. Furthermore, as stated above, the edge of the head 18 is disposed parallel to the case body and the tape leaves spool 15 at an angle to the axis of the device. Thus, head 18 is inclined relative to the tape feed direction.

Stevens further argues that the Tamai application lacks sufficient information on the construction of the tape dispenser to enable a person of ordinary skill in the art to make and use the claimed invention. Specifically, Stevens argues that the Tamai application contains no explanation of how the peak portion 32 of the head 18 is supported by the case 11.

An analysis of whether the claims are supported by an enabling disclosure requires a determination of whether that disclosure contains sufficient information regarding the subject matter of the appealed claims as to enable one skilled in the pertinent art to make and use the claimed invention. The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

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Thus, the dispositive issue is whether Tamai's disclosure, considering the level of ordinary skill in the art as of the date of Tamai's application, would have enabled a person of such skill to make and use the Tamai device without undue experimentation.

In our view, Stevens has not met its burden with respect to this aspect of the enablement issue because Stevens has not even addressed the issue of whether a person of ordinary skill in the art would have known how to attach the head 18 to the case 11 without undue experimentation. In other words, even though the connection of the head 18 to the case 11 is not explicitly disclosed in the Tamai application, Stevens has the burden of establishing that a person skilled in the art would not have known how to secure the head 18 to the case without undue experimentation. This Stevens has not done and as such this portion of the enablement argument also fails.

In view of the foregoing, we will not modify the interlocutory order denying Steven's motion under 37 CFR § 1.633(a).

Tamai's benefit application

In the notice declaring this interference, Tamai was accorded the benefit of an application Serial No. 08/030,183 filed March 29, 1993 ("183 application"). Stevens has filed a

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motion under 37 CFR § 1.633(g) requesting that Tamai be denied benefit of this application because in Stevens' opinion, Tamai's application does not contain adequate support for the following claim limitation:

the tip includes guide means on either side of the edge which operate in conjunction with the shape of the tip for twisting the tape so that the path of the tape around the edge between the guide means is in a plane substantially perpendicular to said edge and inclined to the feed direction.

In order to prevail on this motion, Stevens must prove that the '183 application does not describe an embodiment within the scope of the count. Hunt v. Treppschurch, 523 F.2d 1386, 1389, 187 USPQ 426, 429 (CCPA 1975).

Before this motion can be analyzed, we must first construe the elements included in the count. Specifically, we must interpret what is meant in the count by the language "tip," "guide means," and "inclined to the feed direction."

We note that Stevens has compared the language of claim 20 of the Tamai application with the disclosure of the '183 application and asserts that Tamai's claim 20 is not supported by the '183 application.

Benefit for the purposes of priority in an interference declared under 35 U.S.C. § 135(a) is something different than benefit for the purpose of overcoming prior art. Anderson v.

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Norman, 185 USPQ 371, 372 (Comm'r Pat. 1968). A benefit application need only describe a single enabled embodiment within the scope of the count to constitute a constructive reduction to practice of the invention of the count. Hunt v. Treppschuh, 523 F.2d at 1389, 187 USPQ at 429; see also Weil v. Fritz, 572 F.2d 856, 865 n.16, 196 USPQ 600, 608 n.16 (CCPA 1978).

For an earlier-filed application to serve as constructive reduction to practice of the subject matter of an interference count, the earlier application must reasonably convey that the inventor had possession at the time of the later claimed subject matter.

It is well settled that counts should be given their broadest reasonable interpretation and that only when there is ambiguity can resort be had to the specification. Reese v. Hurst, 661 F.2d 1222, 1236, 211 USPQ 936, 949-50 (CCPA 1981); In re Baxter, 656 F.2d 679, 686, 210 USPQ 795, 802 (CCPA 1981). We note that broad count language is not ambiguous merely because it reads on more than one embodiment. Kroekel v. Shah, 558 F.2d 29, 32, 194 USPQ 544, 547 (CCPA 1977). Nor is an ambiguity established by the fact that the parties offer different interpretations of the count. Id. The rationale for this reasoning is that when an applicant selects language which is somewhat broad in scope, he takes the risk that others with

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specifically different structures may be able to meet the language selected; he will not be permitted to later urge that the selected language should only be read in light of his disclosure merely because the language originated with him.

Hemstreet v. Rohland, 433 F.2d 1403, 1406, 167 USPQ 761, 763 (CCPA 1970).

The count includes a tip having an edge for pressing the tape against the surface. Stevens has not established that this language is ambiguous. In fact, Stevens has not addressed the ambiguity of the count language in their opening brief. In the reply brief, Stevens argues that if an ambiguity exists, it arises from the interpretation given the term "tip" by the interlocutory order and by Tamai. However, Stevens must prove that there is an ambiguity in the count language itself to warrant resort to the Stevens specification to interpret the count.

We do not find that there is ambiguity in regard to the language in the count directed to the tip and as such, we will give this language its broadest reasonable interpretation.

In regard to the language "guide means on either side of the . . . tip . . . for twisting the tape" which is set out in means plus function format, it is interpreted in view of the

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specification of the Tamai application or the Stevens patent in view of our Redeclaration.

When interpreted in view of the Tamai specification, this language refers to the operation of the guide pins 22, 23, flanges 33 and slits 20 which are disposed on either side of the tip (the portion of the device below reel 16) as we discussed above in our analysis of the Stevens' motion under 37 CFR § 1.633(a).

When interpreted in view of the Stevens specification, this language refers to the prepositioning posts 7, 8, and 9, the guide ridges 11 and 12 in the embodiment disclosed in Figure 1 and it refers to the guide pegs 22 and 23 and the wings 16 in the embodiment disclosed in Figure 8. We note that Stevens refers to posts 7, 8, and 9 as guiding means (col. 3, lines 25 to 30).

In regard to the language "the edge is inclined to a feed direction which is the direction of travel of the tape leaving the supply spool," there is no ambiguity. In our view, this language refers to the direction the tape is traveling as it leaves the supply spool 3 in Stevens and the direction the tape is traveling as it leaves the supply spool 15 in Tamai.

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The '183 application

Stevens specifically argues that the '183 disclosure does not disclose the unique tip construction of the count.

Stevens argues that the tip which is disclosed in the '183 application is the head 18 and that the head 18 does not include guide means on either side of the edge. As we stated above, we do not agree that the tip which is recited in the count must be construed so narrowly. In our view, the term "tip" is broad enough to encompass more than the head 18. Specifically, the term tip may be interpreted to include the portion of the '183 device below the reel 16.

Stevens argues that the term "tip" as defined by Webster's Third New International Dictionary is a small piece or part (as a belt, shoe, cane, pen or billiard cue) designed to serve as an end, cap or point and made usually of metal, leather, or other durable substance. Stevens then concludes that only peak portion 32 of head 18 is the tip. We must point out that the proceeding dictionary definition indicates that the tip may be a part which serves as an end. In addition, the first definition given for "tip" in Webster's Third New International Dictionary as we discussed above is "a pointed or rounded extremity of something" and further defines extremity as "an outlying or terminal part, section or point". When this broad definition is considered, it

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is clear that the broadest reasonable construction of the term "tip" would include the tip member 10 in the Stevens device and the portion below the reel 16 in the Tamai device.

Stevens views the ridges 11 and 12 disclosed in Stevens to be the only elements in the Stevens device which comprise the guide means of the count.

However, Stevens discloses:

A length of tape extending between the supply and take-up spools is guided to pass around the tip edge 6. The guiding means include tape positioning means provided by posts 7, 8, and 9 . . . [col. 3, lines 23 to 27].

Therefore, in our view the guide means in the first embodiment disclosed in Stevens is a combination of elements, namely, the prepositioning posts 7, 8, and 9 and the ridges 11 and 12. In addition, the guide means that is disclosed in the embodiment disclosed in Figure 8 includes pegs 22 and 23 and wing projections 16 which is very similar to the guide means disclosed in Tamai.

In any case, in view of our redeclaration in this interference, the guide means language can be interpreted in terms of the Tamai disclosure or the Stevens disclosure. When this language is interpreted in view of the Tamai disclosure, it is clear that the guide means of the count is disclosed in the

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'183 specification as guide pins 22 and 23, slits 20 and flanges 33 as these elements operate to guide the travel of the tape.

In regard to the language about the direction of travel of the tape leaving the spool, Stevens argues that the '183 disclosure is totally devoid of any discussion of the tape feed direction and the relationship of the tape feed direction to the peak portion 32 of the head 18.

While it is true that the '183 disclosure does not specifically discuss the relationship of the travel of the tape leaving the spool and the edge of the tip, it is clear from Figure 1 of the '183 disclosure, that the tape leaves the feed reel at an inclined angle with respect to the plane of the edge.

Stevens also argues that the '183 application does not meet the enablement requirements of 35 U.S.C. § 112. Steven's argument in regard to enablement is that the '183 application does not explain how to provide guide means on the head 18 and how to arrange the guide means on the head 18 to cooperate with the shape of the head to achieve the travel of the tape in the desired path perpendicular to the peak portion 32 and inclined to the feed direction.

As we have interpreted the tip language of the count to be broad enough to include the portion of the device below the winding reel, we do not find this argument persuasive. The tip

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of the '183 as depicted in Figure 1, includes the guide means as recited in the count as we have discussed above.

In view of the foregoing, the Junior party's motion to deny the Senior party's benefit in the '183 application is denied.

Tamai's PCT and JP applications

Tamai has moved for the benefit of earlier filed PCT and Japanese applications. Tamai has identified the applications as Japanese Patent Application No. 3-68371 ("JP '371") and PCT Application No. PCT/JP92/00947 ("PCT application"). The PCT application is part of the file wrapper of the '183 application and JP '371 is part of the file wrapper for the involved Tamai application and the '183 application. Translation of the JP '371 application is part of the file wrapper of the involved Tamai application. A copy of the translation of the JP '371 application was attached with the motion. Copies of translations of these documents were served on Stevens with the Reply to the Opposition to this motion.

The motion indicates that the written specification of the JP '371 and the PCT application are substantially identical to the specification of the '183 application and that the drawings of the JP '371 application and the PCT application are exactly identical to the drawings of the '183 application and that thus

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Tamai is entitled to the benefit of the JP '371 and PCT application for the same reasons that it is entitled to the benefit of the '183 application.

Stevens has opposed this motion stating that (1) Tamai has failed to submit a copy of the JP '371 and PCT application with the motion, (2) Tamai failed to make a showing that the JP '371 and PCT application constitute a constructive reduction to practice of the count and (3) no statement of material facts was submitted by Tamai to support the motion.

It is true that Tamai did not file a copy of the JP '371 and PCT applications, or a translation of the PCT application with the motion. Tamai did file a translation of the JP '371 application with the motion. In fact, Stevens analyzes the subject matter disclosed in the JP '371 application in its opposition with reference to the translation of the JP '371 application. In addition, copies of both applications are a part of the file wrapper of the '183 application and a translation of the JP '371 application is part of the file wrapper for the involved application. As such, Stevens did have access to the copies and translations of the JP '371 at the time of the motion. Therefore, Tamai's failure to submit copies of the JP '371 application and its translation did not prejudice Stevens. As

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such, in the interest of justice, we will consider the motion as it is directed to JP '371.

However, Tamai did not supply a translation of the PCT application, nor does it appear that Stevens was in possession of the application or the translation. Although Tamai alleges that the PCT application has the same disclosure as the JP '371 and submitted a declaration executed by Sadao Kinashi attesting to the fact that the disclosures of the PCT application and JP '371 are the same, Stevens was not given the opportunity to examine the disclosures and translations for themselves. Therefore, we will not grant the motion as it is directed to the PCT application.

In regard to Stevens' allegation that the motion failed to include a statement of material facts and to prove that the disclosure of the JP '371 application is a constructive reduction to practice of the count, we disagree. The motion clearly states that the drawings of the JP '371 application are identical to the drawings of the '183 application. We note that Figure 1 of the JP '371 application and Figure 1 of the '183 application are identical. And from this figure, it is clear that the '183 device includes the elements of the count. Tamai also argues that the specification of the JP '371 application is substantially identical to the specification of the '183

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application. As such, in our view, Tamai did include in the motion a statement of material facts to prove that the disclosure of the JP '371 application is a constructive reduction to practice of the count.

Stevens also argues that the disclosure of the JP '371 application does not meet the requirements of 35 U.S.C. § 112, first paragraph, because in Stevens' opinion, the disclosure does not contain a written description of the invention of the count and does not enable a person of ordinary skill in the art to make and use the invention of the count. Specifically, Stevens argues that the disclosure of the JP '371 application does not include a guide means on either side of the tip which operates with the tip shape to twist the tape, the tape path is not in a plane substantially perpendicular to the tip edge and that the JP '371 application does not enable a person of ordinary skill in the art to include a guide means in the tip of the device. We do not agree with this analysis for the reasons stated above in our discussion of Tamai's preliminary motion for benefit for the '183 application.

For the foregoing reasons, we will grant the Senior party's motion for benefit as it is directed to the JP '371 application but will deny this motion with regard to the PCT application.

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Motion to suppress and Objections to evidence

Stevens has objected to and moved to suppress the JP '371 and the translation of JP '371 which are Exhibits 6 and 7 respectively. Stevens argues that Tamai did not certify in the Preliminary Motions under 37 CFR § 1.633(f) that the copy of the JP '371 was served on Stevens as is required by 37 CFR § 1.637(f)(2). As we stated above, while it is true that Tamai did not file a copy of JP '371 when the preliminary motion to be accorded the benefit of the filing date of JP '371 was filed, a translation of the document was served with the motion and the document itself was a part of the file wrapper of the '183 application which Stevens had access to. Therefore, in our opinion, it is in the interest of justice that this document be considered as evidence.

Stevens also argues that Tamai has failed to establish that this document is a constructive reduction to practice of the count. However, this argument goes to the sufficiency of the document rather than whether the document should be entered as evidence. In any case, as we discussed above, it is our view that Tamai has established that the JP '371 application is a constructive reduction to practice of the count.

Stevens has also moved to suppress the translation of JP '371 because in Stevens' view, Tamai did not show that the

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translation constitutes a reduction to practice of the count. We do not agree for the reasons stated above.

As such, we consider JP '371 as evidence in spite of the objections of Stevens and the motion as it is directed to JP '371 and its translation is denied.

The motion and the objections are also directed to various other exhibits of Tamai but as these exhibits are not relied on in making our decision, the motion and objections in regard to these other exhibits are moot.

Therefore, Tamai has established a constructive reduction to practice of the count as of July 31, 1991.

Stevens' motion for benefit

Stevens has moved for benefit of the filing date of several European applications. The motion is unopposed. Therefore, we will grant Stevens' motion for benefit. As such, Stevens has established a constructive reduction to practice of the count as of February 10, 1993.

Stevens' motion to redefine

Stevens seeks review of the interlocutory order that denied its motion to redefine the interfering subject matter by designating claims 2 to 5, 7 to 16 and 18 to 21 as not

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corresponding to the count. Stevens alleges that the APJ failed to consider the declaration of Joseph Vallera or to analyze the dependent claims.

We note that a party has the burden of establishing by a preponderance of the evidence that any argued claim is separately patentable or patentably distinct with respect to the prior art in accordance with the guidelines set forth in Graham v. John Deere. See 37 CFR § 1.637(c)(4)(ii) and § 1.601(n). Mere reference to a claimed feature which is not disclosed by the prior art and not included in the count does not per se establish "separate patentability" within the meaning of § 1.601(n). Rather, the question is whether that feature would have been obvious to a person of ordinary skill in the subject art. For example, we note that Stevens does not allege that he knows of no prior art that would render its claims 1 through 5, 7 through 16 and 18 through 21 unpatentable over Tamai's claims.

In regard to claims 2 to 4 and 7 to 10, Stevens argues that the particular features of these dependent claims are not included in the count. With reference to the Form 850, in regard to claims 5, 11 to 16 and 18 to 21, Stevens argues that neither the count nor JP 63-56690 includes or discloses the particular features of the count. However, Stevens has not established that the features that are recited in these claims render the claims

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separately patentable from any other claim whose designation to the count Stevens does not dispute. Stevens has failed to present any evidence that the claimed configurations are something more than obvious variations well within the ordinary skill of those versed in the art. Nor has Stevens established or even argued that the use of the claimed configurations in lieu of that disclosed in the prior art solves a particular problem or otherwise provides a particular benefit. In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

For example, claim 2 recites that the guide means comprises a linear edge around which the tape passes from one side to the other side. Stevens argues that the count does not include such a linear edge. Stevens has not established that this edge has patentable significance. In this regard, we note that the other embodiments disclosed in Stevens do not include such an edge (see Figures 6 to 9). In addition, Stevens has not pointed to any portion of the specification, and we can find none, which establishes that the provision of the linear edge as the guide means solves any problems or produces any unexpected results.

In regard to claim 5, for example, Stevens argues that neither JP 63-56690 nor the count includes tape positioning means to determine a first fixed position from which the tape passes to the tip in the feed direction. While this may be so, Stevens has

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not established that the provision of the fixed position solves any problem or produces any unexpected result and would therefore render claim 5 separately patentable. Again, as we view the embodiment in Figures 6 and 7, no such fixed position is provided.

Stevens directs our attention to the declaration of Joseph Vallera (JP record, tab 2) which the Junior party asserts was misconstrued by the examiner and incorrectly applied to Stevens' claims 5, 11 to 16 and 18 to 21. Stevens does not indicate where such analysis is located in the Vallera declaration. We have reviewed the Vallera declaration and fail to find an analysis of how the JP 63-56690 reference relates to the subject matter of claims 5, 11 to 16 and 18 to 21. The Vallera declaration does discuss the JP 63-56690 reference on page 17 but only discusses what the JP 63-56690 reference teaches. The Vallera declaration does not discuss claims 5, 11 to 16 and 18 to 21 in relation to the JP 63-56690 reference. The Vallera declaration does not discuss the obviousness of the features recited in claims 5, 11 to 16 and 18 to 21.

In view of the foregoing, we will not modify the interlocutory order denying this motion.

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Judgment

Because Tamai has established a constructive reduction to practice of July 31, 1991 and Stevens has established a constructive reduction to practice of February 10, 1993, judgment is herein entered against Stevens. Accordingly, Stevens is not entitled to claims 1 through 5, 7 through 16 and 18 through 21 of their involved patent or of claims 1 through 5, 7 through 16 and 18 through 21 of their reissue application which correspond to the count.

In view of the Redeclaration of the interference (supra at 4-5), the parties shall, within the time set for requesting reconsideration under 37 CFR § 1.658(b), present any arguments

for reconsideration and, if the parties present any new arguments, explain why the arguments are necessitated by the Redeclaration.

Sally C. Medley
Administrative Patent Judge

MEC:tdl

Interference No. 103,662

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